

In paragraph 3 of the outstanding Office Action, independent claims 1 and 24 together with claims 2, 9-10, 18, and 25-26 dependent therefrom were rejected under 35 USC § 102 as being anticipated by Penkethman. However, for the following reasons, it is submitted that independent claims 1 and 24 and that claims 2, 9-10 and 18 dependent from claim 1 are all allowable over this reference.

Penkethman in figures 2 and 3 discloses a quasi-confocal microprobe 200 (see column 5 lines 59 and 60). The system is described as "quasi-confocal" because illuminating fiber 210 has a tip 210b that is mapped to a confocal point 311 that is *different* from the focal point 321 of the tip 220b of light receiving fiber 220; that is, an arrangement that is decidedly not confocal. Light emitted from the sample within shaded region 315a or 315b (see figure 3) is collected by light collecting fiber 220 provided that it either passes through focus 321 or would do so if projected backwards to that focal point. Lens 215, according to the Examiner's construction, acts as a beam splitter to separate the two beams.

Initially, it should be noted that the claims of the present application are directed to confocal endoscopes or microscopes, or methods for performing confocal endoscopy or microscopy. For this reason alone the disclosure of Penkethman does not anticipate the claimed invention. Penkethman employs lens 215 specifically to provide the described quasi-confocality. That is, Penkethman has in fact failed to find a satisfactory solution according to his invention in which true confocality is provided, and consequently his disclosure falls well short of that provided by the present invention.

However, in addition present claims 1 and 24 have been amended to more clearly distinguish the present invention from the disclosure of Penkethman. The

present invention as defined in these claims uses a beam splitter that is separate from the focusing lens, so these claims have been amended to define a light condenser (for example, lens 26 in the embodiment of figure 1) located optically between the beam splitter and the sample (and hence separate from either). This arrangement is clearly different from that of Penkethman where, as the Examiner points out, any beam splitting is provided by lens 215. Thus, a light condenser cannot be located between the "beam splitter" and the "sample" as, according to Penkethman, the light condenser *is* the beam splitter.

The present invention, therefore, as defined in the amended claims thus provides a solution that can be employed in a true confocal system, a solution that Penkethman fails to anticipate or in any way suggest. It is submitted, therefore, that independent claim 1 together with dependent claims 2, 9, 10, and 18 as well as independent claim 24 are novel and inventive over the disclosure of Penkethman.

In paragraph 5 of the outstanding Office Action, dependent claims 11-12 and independent claim 44 were rejected under 35 USC § 103 as being obvious over Penkethman. However, for the following reasons, it is submitted that claims 11, 12 and 44 are allowable over this reference.

Firstly, it is submitted, that owing to the amendment of independent claim 1, that dependent claims 11 and 12 are now novel and inventive over the disclosure of Penkethman. In addition, claim 12 as amended now defines that the incident beam and the returning light are parallel between the beam splitter and the light condenser; and that this feature has no analogue in the disclosure of Penkethman, and there are no

straightforward design steps that would lead the skilled person from the arrangement of Penkethman to that defined in claim 12 as amended.

Accordingly, it is submitted that dependent claims 11 and 12 are patentable over the disclosure of Penkethman.

Similarly, independent claim 44 has been amended along the same lines as claims 1 and 24, to refer to the use of a light condenser for focusing the incident beam onto the sample, and through which returning light also passes but in the form of a broader beam. It is submitted that claim 44 as amended thus recites a method for performing *confocal* endoscopy or microscopy that is not obvious in the light of disclosure of Penkethman, yet provides a simple approach (illustrated, by way of example, in figure 11) by means of which true confocal endoscopy or microscopy can be performed.

In fact, the simplicity of the arrangement of figure 11, it is also submitted, supports its inventiveness when it is borne in mind that—despite the solutions offered by Penkethman—the cited prior art in no way suggest a comparably simple solution for performing true confocal imaging.

Therefore, for all of the foregoing reasons, it is submitted that independent claim 11 is allowable over Penkethman.

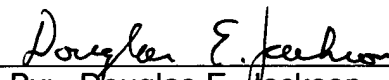
In summary, it is submitted that independent claims 1, 24 and 44 are all allowable over Penkethman. For these same reasons, it is submitted that claims 2, 9-12, and 18 dependent from claim 1 are similarly allowable. Likewise, non-elected claims 3-8, 13-17, 19-23, 42-43 and 45-47 which now depend from allowable elected independent claim 1 are also allowable. Further, non-elected independent claims 48

and 56 have also been amended. These non-elected independent claims have been amended in the same manners as independent claims 1 and 24, so that these claims will be allowable in at least the same manner as the elected independent claims. In addition, non-elected dependent claims 49-55 and 57-62 dependent respectively from non-elected independent claims 48 and 56 are thus also allowable therewith.

Further and favorable action is solicited.

Respectfully submitted,

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